

REMARKS

The application has been reviewed in light of the Office Action dated May 5, 2010. Claims 1-16 are pending in the present application, with claims 1, 2 and 10 being in independent form. Claims 17-37 are canceled. In this Amendment, claims 10, 11, 15 and 16 have been amended to correct minor informalities. It is respectfully submitted that the amendment is fully supported by the specification as originally filed and introduces no new subject matter, and the pending claims 1-16 are in condition for allowance.

Drawings

Applicant submits a "REPLACEMENT SHEET" to amend FIG. 6 in the drawings. On the "REPLACEMENT SHEET", the word "AMENDED" has been added at the bottom of FIG. 6.

Claim Objections and Rejection under 35 U.S.C. § 251

Claims 17-37 are objected to for not being underlined. Claims 17-37 are also rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

By this Amendment, Applicant has canceled claims 17-37. Accordingly, Applicant respectfully requests that the rejection of claims 17-37 under 35 U.S.C. § 251 be withdrawn.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Merchant et al., US Pat. 5,523,259 (hereinafter "Merchant").

During the prosecution of the original application (09/112,885), claims 1-11, 14-16 and 18 were rejected under 35 U.S.C. § 102(c) as being anticipated by Merchant and claims 12 and 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Merchant in view of Colgan et al., US Pat. 5,565,707 (see Non-Final Action mailed on 06/27/00).

In response to the Non-Final Action mailed on 06/27/00, Applicant submitted a duly executed 37 CFR § 1.131 Affidavit to overcome these rejections (see Response to Office Action dated 09/18/00). The Affidavit included facts and data sheets showing a completion of the invention by Applicant in this country prior to November 16, 1992, more than two years before the filing date of the application from which Merchant was issued. A copy of the Affidavit is attached.

In addition, Applicant submits a newly executed declaration under 37 CFR § 1.131 with attached exhibits A, B, C & D. The photographs in Exhibits A, B, C & D are photocopies of the original photographs labeled Exhibits A, B, C & D included in the Affidavit mention above. The original photographs were submitted along with the Affidavit to the United States Patent and Trademark Office on September 18, 2000.

Specifically, the newly executed declaration and attached exhibits A, B, C & D show that prior to November 16, 1992, Applicant conceived and reduced to practice of the idea for at least one embodiment of the invention for a soft metal conductor for use in a semiconductor device comprising grains having grain sizes larger than 200 nm so as to provide a substantially scratch-free surface upon polishing in a subsequent chemical mechanical polishing step, said soft metal conductor being formed by at least one metal selected from the group consisting of Al, Cu and Ag, and a method of making such a soft metal conductor for use in a semiconductor device.

Furthermore, the newly executed declaration and attached exhibits A, B, C & D also show that prior to November 16, 1992, Applicant conceived and reduced to practice of the idea for at least one embodiment of the invention for an electrically conducting soft metal structure for use in a semiconductor device comprising: an uppermost layer consisting of grains having grain sizes not smaller than 200 nm, and a second layer contiguous with and immediately adjacent to said uppermost layer consisting of grains having grain sizes not larger than about 20% of the thickness of said soft metal structure, and a method of making such an electrically conducting soft metal structure for use in a semiconductor device.

Thus, Applicant submits that the newly executed declaration and attached exhibits A, B, C & D, in combination with the 37 CFR § 1.131 Affidavit and attached exhibits A, B, C & D submitted on 09/18/00, establish conception and reduction to practice of the invention in the application prior to November 16, 1992, more than two years before the filing date of the application from which Merchant was issued. These evidences are also sufficient to persuade one skilled in the art that Applicants were in possession of the invention as claimed prior to November 16, 1992.

Thus, Merchant cannot be a valid reference against Applicant's invention. Since Merchant is not a valid prior art reference, Applicant respectfully requests that the rejection of claims 1-16 under 35 U.S.C. § 102(e) be withdrawn.

Rejection of Claims under 35 U.S.C. § 103

Claims 17-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Merchant in view of Chang et al., US Pat 5,266,446 (hereinafter "Chang").

By this Amendment, Applicant has canceled claims 17-37. Accordingly, Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-16 are now in condition for allowance. Accordingly, early and favorable consideration of this application is respectfully requested. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, the Examiner is respectfully requested to contact Applicant's undersigned representative at the telephone number indicated below.

If any fees are required, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 09-0458.

Respectfully Submitted,

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